

ATTORNEY DOCKET NO. BILL01-00004
U.S. SERIAL NO. 09/503,532
PATENT

REMARKS

Claims 1-4, 8, 9, 11-19, 23, 24 and 26-38 are pending in the application.

Claims 1-4, 8, 9, 11-19, 23, 24 and 26-30 have been rejected.

Claims 31-38 have been withdrawn from consideration.

Reconsideration of the Claims is respectfully requested.

I. RESTRICTION OF CLAIMS 31-38

The Office Action states that Claim 31-38 are directed to an invention that is independent or distinct from the invention as originally claimed. This restriction is respectfully traversed.

The Office Action has failed to establish or provide a prima facie basis that Claims 31-38 are directed to an invention that is independent or distinct from the invention presented in the currently pending claims. The Office Action simply recite an element/feature of independent Claim 31 and concludes, therefore, that Claims 31-38 are independent or distinct.

Accordingly, the Applicant requests examination of Claims 31-38 or a prima facie showing that Claims 31-38 are independent and distinct and properly the subject of the present restriction requirement.

II. OBJECTIONS TO CLAIMS 11, 12, 14 AND 27

The present Office Action objects to Claims 11, 12, 14 and 27. However, the comments concerning Claims 12 and 14 do not include a description of any objections to the language of the

ATTORNEY DOCKET NO. BILL01-00004
U.S. SERIAL NO. 09/503,532
PATENT

claims. Similarly, with respect to Claims 12 and 27, it is unclear as to which specific claim language is being objected to and the basis for the objection.

III. REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 3-4, 8, 9, 11-15, 16, 18, 19, 23, 24 and 26-29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Terranova (US 6,422,464 B1). Claims 1-2, 15, 16-17 and 30 were rejected under 35 U.S.C. § 102(e) as being anticipated by McCall (US 6,152,591). The rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The final Office Action has essentially failed to rebut the Applicant's patentability arguments. In particular, independent Claims 1 and 16 (and all claims that depend therefrom) are directed to advertising during a commercial transaction. During a commercial transaction, programming information is presented to a customer on a display at a commercial transaction location. Customer profile information is transmitted from a central location to the commercial transaction location, where it is used to produce/generate the programming information by filtering

ATTORNEY DOCKET NO. BILL01-00004
U.S. SERIAL NO. 09/503,532
PATENT

update information and advertising information that were previously transmitted to and stored at the commercial transaction location. (emphasis supplied). This exemplary feature of Claims 1 and 16 has not been found to be disclosed in either Terranova or McCall.

Though Terranova discloses that a remote host computer can transmit customer preference information to the commercial transaction location (Col.38, lines 34-39; Col. 39, lines 5-14), Terranova appears to contemplate that either (1) the actual information (to be displayed) is transmitted from the host computer to the site controller for display (i.e., the remote host computer (central provider) uses the preference information to filter update information and advertising information while that information is still stored at the central provider, thus only the filtered information is transmitted to and displayed at the commercial transaction location. (Col 39, lines 12-20; Col.37, lines 42-52.)), or (2) the actual information (to be displayed) is provided by "other data networks or systems" which is apparently sent to the commercial transaction location (Col. 39, lines 14-20) and displayed.

In distinct contrast, Applicant's customer profile information (transmitted from the central provider) is used at the commercial transaction location to filter the update and advertising information that was previously stored at the commercial transaction location. Thus, the received customer profile information is used to generate programming data (to be displayed) from the update and advertising information previously stored at the commercial transaction location.

In addition, although Terranova discloses that advertising information may be provided from a dedicated auxiliary audio/video source (Col. 40, lines 22-24, FIG. 5), this represents only locally-

ATTORNEY DOCKET NO. BILL01-00004
U.S. SERIAL NO. 09/503,532
PATENT

stored advertising information not received via communications from a central location. There is no disclosure regarding transmission of this advertising information from a central location and storage at the commercial transaction location, and then filtering of the stored advertising information (previously transmitted to and stored at the commercial transaction location), as recited in independent Claims 1 and 16.

McCall discloses that historical information about the customer can be stored in a database (Col. 9, lines 60-66; Col. 11, lines 9-10). This can represent customer preference information, and it is used to determine what information stored in the database will be presented to the customer (Col. 9, lines 54-66; Col. 11, lines 1-13; Col. 4, lines 17-19). Therefore, the customer preference information is stored in the same database as the information from which the customer presentation will be selected in accordance with the preference information (See also, Col. 11, lines 34-57; Col. 7, lines 28-30).

McCall also discloses that the database can be local to the site of the commercial transaction, or can be located remotely from the site (Col. 5, lines 44-54). When the database is local, there is no disclosure of, and no need for, any transmission of the customer preference information from a central location to the commercial transaction location, because the customer preference information is already stored at the same location as the information that it will filter. When the database is located remotely from the commercial transaction location, the customer preference information could be transmitted from the remote database to the commercial transaction location (see, e.g., Col. 11, lines 34-42). McCall fails to disclose that the stored programming information

ATTORNEY DOCKET NO. BILL01-00004
U.S. SERIAL NO. 09/503,532
PATENT

is first transmitted from the remote database and stored at the commercial transaction location, and is then filtered by the customer preference information at the commercial transaction location.

In addition, McCall discloses customer preference information in the form of a CUSTOMER flag. The CUSTOMER flag is constructed from information provided by the customer at the commercial transaction location. For example, the CUSTOMER flag can indicate whether the customer is a novice (having asked for detailed instructions) or an expert (not having asked for detailed instructions), and whether the customer has elected to pay inside or outside. However, the CUSTOMER flag information is not transmitted to the commercial transaction location from a central location, as recited in independent Claims 1 and 16.

As shown above, Terranova or McCall fail to disclose each and every limitation/feature as arranged in Applicant's independent Claims 1 and 16 (and dependent Claims). Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejections of Claims 1-4, 8, 9, 11-19, 23, 24 and 26-30.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

ATTORNEY DOCKET NO. HILL01-00004
U.S. SERIAL NO. 09/503,532
PATENT

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 8/1/2005


Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@davismunck.com*